

### **REMARKS**

Claims 1-24 were pending in the application. Claim 1 is an independent claim and claims 2-24 depend therefrom. Claims 25-31 were previously withdrawn and are currently canceled. Claims 1-19 and 21-23 are currently amended. The Applicant respectfully requests reconsideration of pending claims 1-24, in light of the above-mentioned amendments and the following remarks.

#### **Rejections Under 35 U.S.C. § 112, Second Paragraph (Claim 6)**

On page 2 of the Office Action, dependent claim 6 was rejected under 35 U.S.C. § 112, second paragraph as being indefinite. The Applicant has amended dependent claim 6 to clarify that the at least one signal input device housed in the second case is at least one cochlear implant signal input device, which is different than the plurality of hearing aid signal input devices recited in Applicant's dependent claim 5. The Applicant respectfully submits that the clarifying amendment renders the rejection under 35 U.S.C. § 112, second paragraph, moot. Therefore, the Applicant respectfully requests that the rejection of Applicant's dependent claim 6 under 35 U.S.C. § 112, second paragraph, be withdrawn.

#### **Rejections Under 35 U.S.C. § 103(a) – Miller in view of Nielsen, Killion, Borstel, Nordqvist or AAPA (Claims 1-3, 5, 9-11, 13-14 and 17-24)**

On pages 3-5 of the Office Action, independent claim 1 and dependent claims 2-3, 5, 9-11, 13-14 and 17-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller (U.S. Patent No. 6,620,094) in view of any one of Nielsen et al. (U.S. Patent No. 6,839,447, hereinafter "Nielsen"), Killion et al. (U.S. Patent No. 5,524,056, hereinafter "Killion"), Borstel (U.S. Patent No. 4,467,145), Nordqvist et al. (U.S. Patent No. 6,862,359, hereinafter "Nordqvist"), or Applicant's Admitted Prior Art (Paragraph [0011] of Applicant's Specification, hereinafter "AAPA"). The

Applicant respectfully traverses the rejections for at least the following reasons.

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

Regarding claim 1, the Applicant respectfully submits that the combination of references fails to teach, suggest, or disclose, for example, "wherein said existing cochlear implant is retrofitted with said hearing aid preprocessing device by communicatively coupling an output of said hearing aid preprocessing device with one or both of said at least one cochlear implant signal input device of said existing cochlear implant," as set forth in Applicant's independent claim 1.

Nowhere in the combination of references is there any mention of retrofitting an existing cochlear implant with a hearing aid preprocessing device. In fact, nowhere in the combination of references is there any mention of retrofitting or a hearing aid preprocessing device communicatively coupled to an existing cochlear implant in any way, shape or form. Thus, the combination of references clearly fail to disclose “wherein said existing cochlear implant is retrofitted with said hearing aid preprocessing device by communicatively coupling an output of said hearing aid preprocessing device with one or both of said at least one cochlear implant signal input device of said existing cochlear implant,” as recited in Applicant’s independent claim 1. Because the combination of references fails to teach each of the limitations of Applicant’s independent claim 1, the Applicant respectfully submits that the rejection of Applicant’s independent claim 1 under 35 U.S.C. § 103(a), cannot be maintained.

Therefore, for at least the above stated reasons, Applicant respectfully submits that the combination of references fails to teach, suggest, or disclose Applicant’s invention as set forth in claim 1. The Applicant believes that claim 1 is allowable over the combination of references. Applicant respectfully submits that claim 1 is an independent claim, and that claims 2-24 depend either directly or indirectly from independent claim 1. Because claims 2-24 depend from claim 1, Applicant respectfully submits that claims 2-24 are allowable over the combination of references, as well. The Applicant further submits that each of claims 2-24 is independently allowable. The Applicant respectfully requests, therefore, that the rejection of claims 1-3, 5, 9-11, 13-14 and 17-24 under 35 U.S.C. §103(a), be withdrawn.

**Rejections Under 35 U.S.C. §103(a) – Miller and Griffith (Claims 4, 6-8, 12 and 15-16)**

On page 5 of the Office Action, dependent claims 4, 6-8, 12 and 15-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Miller or Miller in view of Griffith et al. (U.S. Patent No. 6,842,647, hereinafter “Griffith”). The Applicant respectfully submits that claims 4, 6-8, 12 and 15-16 depend either directly or indirectly from independent claim 1. Applicant believes that

claim 1 is allowable over the proposed combination of references, in that Griffith fails to overcome the deficiencies of Miller, as set forth above. Because claims 4, 6-8, 12 and 15-16 depend from independent claim 1, Applicant respectfully submits that claims 4, 6-8, 12 and 15-16 are allowable over the proposed combination of Miller in view of Griffith, as well. Applicant also asserts that each of claims 4, 6-8, 12 and 15-16 is independently allowable.

Therefore, for at least the reasons set forth above, Applicant respectfully requests that the rejections of claims 4, 6-8, 12 and 15-16 under 35 U.S.C. §103(a) be withdrawn.

#### **Final Matters**

The Office Action makes various statements regarding claims 1-24, 35 U.S.C. § 103(a), the Miller reference, the Nielsen reference, the Killion reference, the Borstel reference, the Nordqvist reference, the AAPA reference, the Griffith reference, one of ordinary skill in the art, etc. that are now moot in view of the above amendments and/or arguments. Thus, the Applicant will not address all of such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

Applicant reserves the right to argue additional reasons supporting the allowability of claims 1-24 should the need arise in the future.

**CONCLUSION**

Applicant respectfully submits that claims 1-24 are in condition for allowance, and requests that the application be passed to issue.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

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Respectfully submitted,

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